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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,642	01/20/2004	Mark Horton	30,800-00US	5319
7590 John F. Klos, Esq. Fulbright & Jaworski L.L.P. Suite 2100 80 South Eighth Street Minneapolis, MN 55402-2112			EXAMINER PRONE, JASON D	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 07/09/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/762,642	Applicant(s) HORTON, MARK	
	Examiner Jason Prone	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)                |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application      |
| Paper No(s)/Mail Date _____  | 6) <input checked="" type="checkbox"/> Other: <u>Appendix A</u> 7-2-07 |

### **DETAILED ACTION**

With regards to claims 11 and 18-20, these claims do not incorporate the correct status identifiers according to 37 CFR 1.121(c). Claim 11 should be identified as (cancelled). Claims 18-20 do not appear to be present in the original set of claims and therefore should be re-identified as (previously presented).

#### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

In this case, the duty to disclose incorporates the incorrect statement "I acknowledge the duty to disclose information which is material to the examination of this application under 37 C.F.R. 1.56a". The correct duty to disclose statement is as follows:

"I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56."

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a "pad with a width narrower than the handle" and a "pad terminating at the neck portion" of claims 1 and 17, and a "finger stop structure with a width narrower than the handle" and a "finger stop

Art Unit: 3724

structure terminating at the neck portion" of claim 12, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because it is unclear if the portion represented by item 30 in Figures 1 is supposed to show a pad structure. This portion has a dark border around it but due to the shading being the same as the rest of the handle it is unclear if this dark border is to represent anything. Figure 2 clearly shows a pad structure. It is recommended that the shading be removed from Figures 1 and 2 (See Appendix A for correct shadings according to M.P.E.P. 608.02). In Figure 3, item 30's

Art Unit: 3724

reference line should have an arrowhead at the end to represent that entire area.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

4. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The newly amended portion of claim 1 now discloses the finger stop structure is made of rubber.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 2, 4, 6-10, and 12-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1 and 17, the phrases "with a width of the pad being substantially narrower than a width of a handle portion proximate to the pad", "said pad being a rubber material being substantially more resilient than said handle portion", and "the pad extends...terminating at the neck portion" are new matter. The specification provides support for this pad on lines 9-10 of page 3. However, there is no support for a specific width of the pad and the angled views of the top portion provided in the Figures also do not provide support. The specification does support the pad being made of rubber however does not provide support for this rubber being more resilient than the handle portion. Figure 2 clearly shows the pad terminating well before the neck portion. If the pad terminated at the neck portion it would have to extend over the hump and terminate near item 38.

In claim 12, the phrases "with a width of the finger stop structure being substantially narrower than a width of a handle portion proximate to the stop structure" and "the pad extends...terminating at the neck portion" are new matter. See above.

Art Unit: 3724

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 2, 4, 6-10, and 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claims 1 and 12, the specification paragraph [012] and Figure 3 clearly disclose that it is the inclined portion of the handle that makes-up the stop structure. Amended claims 1 and 17 disclose that the stop structure is a pad that extends along a ridge that represents an enlarged portion of the handle. However, paragraph [012] and Figure 3 clearly disclose that the structure now labeled as "a ridge" is the stop structure. So the "pad" is not the stop structure the enlarged portion of the handle is the "stop structure" and the pad is just one part of the stop structure.

The claims should be amended to use the term "finger stop structure" to represent the enlarged portion of the handle and replace the term "ridge". And "the finger stop structure includes a elongated resilient pad" should be the "pad" introduction phrase. Basically, the names used need to be amended and the term "ridge" should be removed.

9. Claim 12 recites the limitation "the pad" on line 13. There is insufficient antecedent basis for this limitation in the claim.

In claim 13, the term "an elongated pad" is unclear. It is uncertain if this pad is the same structure as the pad previously disclosed on line 13 of claim 12.

Art Unit: 3724

10. Claim 17 recites the limitation "the pad" on line 7. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, and 10 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over Cronheim (3,711,945) in view of Scheminger (5,555,625) Stowell et al. (RE37,190), and Whitemiller et al. (2005/0022390) with further evidence patents McGuyer (D509,114) and Garret (874,583). Cronheim discloses the invention including a cutting wheel (31), a handle (1) having a finger stop (19), a generally planar top surface extending along a length of the handle and capable of engaging an extended index finger (2), a pair of side surfaces extending between the top and bottom surfaces (6, 6'), the side surfaces are wider than the top surface (Fig. 6), a neck portion coupled to the cutting wheel and extending from a first end of the handle (34), the neck portion has a length greater than or equal to a diameter of the cutting wheel (34), and the finger stop structure is an elongated pad extending along a top surface of the handle (19), a width of the pad being substantially narrower than a width of a handle portion (Fig. 2), a length of the pad extends upwardly away from a base of the handle (19), and the handle is formed of wood (Column 1 lines 61-62).



However, Cronheim fails to disclose the neck portion arcuately extends from the first end of the handle, the finger stop/pad is made of rubber, and the ridge defines an enlarged portion of the handle.

Schmeniger teaches that it is old and well known in the art of handheld cutters to incorporate an arcuate neck portion (18 or 20). McGuyer and Garret provide further evidence that arcuate neck portions are old and well known in the art of wheel cutters. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Cronheim with an arcuate neck portion, as taught by Scheminger, as an alternate way of extending the neck towards the cutter wheel. The angled neck portion performs the exact same function as an arcuate neck portion.

Stowell et al. teaches it is old and well known in the art of finger pads on handle held tools to incorporate a finger stop made of rubber (18A). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Cronheim with a stop made from rubber, as taught by Stowell et al., to better prevent the user's hand from slipping while in use.

Whitemiller et al. teaches that it is old and well known in the art of handheld cutters to incorporate a ridge that defines an enlarged portion of the handle (57). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Cronheim with a ridge, as taught by Whitemiller et al., to allow the user to provide more of a down force on the blade.

13. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cronheim in view of Scheminger, Stowell et al., and Whitemiller et al. as applied to

Art Unit: 3724

claim 1 above, and further in view of Arend et al. (6,044,565). Cronheim in view of Scheminger, Stowell et al., and Whitemiller et al. disclose the invention however, Cronheim remains silent on the specific dimensions of the cutting apparatus and, therefore, fails to disclose, the ratio of the length of the handle to a diameter of the wheel is approximately 3 to 1, the length of the handle is approximately 6 inches, the diameter of the cutting wheel is approximately 2 to 3 inches, and the handle is formed of plastic.

It is noted that the term "approximate" means very similar (The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton Mifflin Company. Published by Houghton Mifflin Company. All rights reserved). In light of this definition, Arend et al. teaches, in regards to claim 4, the ratio of the length of the handle to a diameter of the wheel is approximately 3 to 1 (6.25 and 1.75 is approximately a 3 to 1 ratio, Column 3 lines 7-23). In regards to claims 6-8, Arend et al. teaches the length of the handle is approximately 6 inches (Column 3 line 10, 6.25 inches is approximately 6 inches). In regards to claim 9, Arend et al. teaches the diameter of the cutting wheel is approximately 2 to 3 inches (Column 3 line 13, 1.75 inches is approximately 2 inches). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Cronheim in view of Scheminger, Stowell et al., and Whitemiller et al. with specific dimensions/ratios, as taught by Arend et al., to allow the apparatus to best conform to an average user's hand.

14. Claims 12 and 13 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over Webb (5,569,285) in view of Garret, and Cronheim further in view of Whitemiller et al. and Stowell et al. Webb discloses the invention including, in

Art Unit: 3724

regards to claim 12, a cutting wheel (10), a handle made of a first material and having a top surface along a first end adapted to engage a longitudinally extended index finger (7), the handle having a pair of generally planar side surfaces and a generally planar bottom surface (Fig. 1), the side surfaces being wider than the top surface so that the cross-section is generally rectangular (13), a neck extending from the first end of the handle (Fig. 1), and the length of the neck is greater than twice the diameter of the cutting wheel (Fig. 1).

However, Webb fails to disclose a finger stop structure connected to the top surface along a first end and positioned to be capable of confronting the tip of an index finger, the finger stop is made of a slip-resistant material, the width of the finger stop structure is narrower than a width of the handle, a length of the pad extends upwardly away from a base of the handle, and a ridge defining an enlarged portion of the handle and the neck extends arcuately from the handle.

Cronheim teaches that it is old and well known in the art of cutting wheel handles to incorporate a finger stop structure connected to the top surface along a first end and positioned to be capable of confronting the tip of an index finger (19), the width of the finger stop structure is narrower than a width of the handle (Fig. 2), a length of the pad extends upwardly away from a base of the handle (19). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Webb with a finger stop, as taught by Cronheim, to make the handle more ergonomically pleasing.

Art Unit: 3724

Stowell et al. teaches that it is old and well known in the art of tool handles to incorporate a finger stop that is made of a slip-resistant material (19). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Webb in view of Cronheim with a stop made from a non-slip material, as taught by Stowell et al., to prevent the user's hand from slipping while in use.

Whitemiller et al. teaches that it is old and well known in the art of handheld cutters to incorporate a ridge that defines an enlarged portion of the handle (57). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Webb in view of Cronheim with a ridge, as taught by Whitemiller et al., to allow the user to provide more of a down force on the blade.

Garret teaches that it is old and well known in the art of cutter wheel to incorporate an arcuate neck portion (4<sup>a</sup>). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Webb with an arcuate neck portion, as taught by Garret, to make it easier for the user to apply a downward force to the cutting wheel.

15. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webb in view of Garret and Cronheim further in view of Whitemiller et al. and Stowell et al. as applied to claim 12 above, and further in view of Arend et al. Webb in view of Garret and Cronheim further in view of Whitemiller et al. and Stowell et al. disclose the invention however, Webb remains silent on the specific dimensions of the cutting apparatus and, therefore, fails to disclose, the ratio of the length of the handle to a

Art Unit: 3724

diameter of the wheel is approximately 3 to 1 and the diameter of the cutting wheel is approximately 2 to 3 inches.

It is noted that the term "approximate" means very similar (The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton Mifflin Company. Published by Houghton Mifflin Company. All rights reserved). In light of this definition, Arend et al. teaches, in regards to claim 15, the ratio of the length of the handle to a diameter of the wheel is approximately 3 to 1 (6.25 and 1.75 is approximately a 3 to 1 ratio, Column 3 lines 7-23). In regards to claim 14 and 16, Arend et al. teaches the diameter of the cutting wheel is approximately 2 to 3 inches (Column 3 line 13, 1.75 inches is approximately 2 inches). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Webb in view of Garret and Cronheim further in view of Whitemiller et al. and Stowell et al. with specific dimensions/ratios, as taught by Arend et al., to allow the apparatus to best conform to an average user's hand.

16. Claims 17-20 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over Cronheim in view of Arend et al. and Whitemiller et al. In regards to claim 17, Cronheim discloses the invention including providing a cutting device having a cutting wheel (31) and a handle (1), a finger stop (19), the handle having a first end and a top surface adapted to engage an index finger (2), the handle including a pair of generally planar side surfaces extending between the top and bottom surfaces (6 and 6'), the side surfaces being wider than the top surface (Fig. 6), placing a finger along the top with a finger tip engaging the finger stop (19) grasping the handle of the cutting device with one end of the cutting device being held entirely within the palm of the user's hand and one surface of the handle engaging a substantial portion of the user's

Art Unit: 3724

index finger (1), and a tip of the index finger engaging the finger stop (19) and rolling the cutting wheel across a flat food item to cut the item (Title).

However, Cronheim fails to disclose the handle having a length of between 4.5 and 7 inches and a ridge defining an enlarged portion of the handle.

Arend et al. teaches that it is old and well known in the art of wheel cutter handles to incorporate handle having a length of between 4.5 and 7 inches (Column 3 lines 7-11). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Cronheim with specific dimensions, as taught by Arend et al., to allow the apparatus to best conform to an average user's hand.

Whitemiller et al. teaches that it is old and well known in the art of handheld cutters to incorporate a ridge that defines an enlarged portion of the handle (57). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Cronheim with a ridge, as taught by Whitemiller et al., to allow the user to provide more of a down force on the blade.

### ***Response to Arguments***

17. Applicant's arguments with respect to claims 1, 2, 4, 6-10, and 12-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3724

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 8:00-5:30, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Application/Control Number: 10/762,642

Page 15

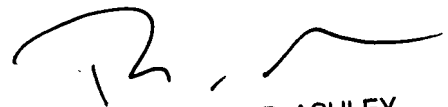
Art Unit: 3724

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 02, 2007



Patent Examiner  
Jason Prone  
Art Unit 3724  
T.C. 3700



BOYER D. ASHLEY  
SUPERVISORY PATENT EXAMINER



Art Unit: 3724

Appendix A

From M.P.E.P. section 608.02

